

**REMARKS**

This is in response to the Office Action of December 1, 2008. A grammatical amendment is made to claim 6. No new matter is introduced. Claims 1-12 remain pending in the application.

In response to the requirement for restriction, Applicants had previously elected the invention identified by the Examiner as Group I. The requirement for restriction is being maintained by the Examiner. Claims 9-12, corresponding to non-elected Groups II and III, are withdrawn from consideration in this application.

In response to the requirement for election of species, Applicants had elected the compound 7-(3-chlorophenyl)-1-phenyl-5-trifluoromethylbenzimidazole. This is the compound of Example 5 in the specification. Claims 1-3, 7, and 8 read on the elected species of invention.

Claims 1-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US 5,554,632 (Teuber). Office Action, pages 5-6. The rejection is respectfully traversed.

The compounds of the present invention are to some extent structurally related to compounds disclosed by Teuber. However, the compounds of the present invention differ from those of Teuber at least with respect to the substituent in the 1-position of the benzimidazole ring. That substituent is designated in Teuber as  $R^3$ .  $R^3$  in Teuber may be phenyl, but when it is phenyl, the 1-phenyl ring in Teuber has a substituent designated as  $R^{11}$ . The substituent  $R^{11}$  in Teuber is itself "phenyl ...; benzimidazolyl ...; or aryl." Thus, in Teuber, the 1-phenyl group on the benzimidazole ring has a large substituent on it. In contrast, in the present invention, the 1-phenyl group on the benzimidazole ring is unsubstituted.

Teuber discloses such compounds as 1-[3-(1-benzimidazolyl)-phenyl]-5-trifluoromethylbenzimidazole. In contrast, Applicants claim compounds, such as 1-phenyl-7-(3-chlorophenyl)-5-trifluoromethylbenzimidazole, which are significantly simpler than the Teuber compounds with respect to the substitution at the 1-position of the benzimidazole ring.

The technical problem solved by the present invention may be regarded as the provision of further compounds which are useful in the treatment of central nervous system diseases and disorders which are responsive to modulation of the GABA<sub>A</sub> receptor complex, and in particular, which are useful in combating anxiety and related diseases. Specification, page 1, lines 11-13. A person of ordinary skill in the art faced with the problem of finding compounds possessing these properties would find no suggestion in the Teuber reference or in the knowledge generally available to persons skilled in the art that would motivate him or her to investigate the compounds of the present invention, in which the R<sup>11</sup> substituent has been eliminated as compared with the compounds taught by Teuber. Nothing in the prior art would provide a reasonable expectation of success – because it was not known prior to Applicants' work that the biological activity of the compounds disclosed by Teuber could be maintained when the R<sup>11</sup> “phenyl ...; benzimidazolyl ...; or aryl” substituent – which is a necessary component of the Teuber compounds – is eliminated.

It is respectfully submitted that the Teuber reference fails to establish a *prima facie* case of obviousness with respect to the presently claimed compounds. Withdrawal of the rejection of record is in order and is earnestly solicited.

On page 6 of the Office Action, claims 1-8 are objected to for containing non-elected subject matter. Applicants are not aware that this is a valid ground for an objection. In fact, whenever there is a generic claim that embraces both an elected species and a non-elected species, that generic claim contains non-elected subject matter. In the present situation, since the elected species is allowable over the prior art, the Examiner is respectfully requested to withdraw the requirement for election of species and to examine all of the species embraced by claim 1.

Should there be any questions concerning the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at the telephone number of the undersigned below.

Application No.: 10/575,380

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: May 1, 2009

Respectfully submitted,

By  #28,977

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